

## **REMARKS**

### **I. Drawings**

Applicants submit an attached Replacement Sheet as Appendix B. This Replacement Sheet includes an amended Figure 26 and replaces the previous sheet number 28 of 33. Amended Figure 26 includes labels for each box shown in the figure.

### **II. Specification**

The Abstract has been amended so that it is less than 150 words. Applicants also submit an amended paragraph at page 1, line 12, that indicates Application Serial No. 09/421,965 is now abandoned. With respect to the other objections to the specification cited in the Office Action, Applicants are not aware of any rule or statute, nor has the Examiner cited any authority, stating that appendices at the end of the specification or references to a docket number are improper and should be deleted. Applicants have therefore not made these requested amendments to the Specification.

### **III. Claim Objections**

Claim 61 has been amended to read “the third wavelength” instead of “the second wavelength” in line 7.

### **IV. Double Patenting**

Claims 54-85 stand rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-46 of U.S. Patent No. 6,135,965, claims 1-35 of U.S. Patent No. 6,258,576, claims 1-46 of U.S. Patent No. 6,095,982, claims 1-4 of U.S. Patent No. 5,697,373, claims 1-15 of U.S. Patent 5,612,540 and claims 1-13 of U.S. Patent No. 6,241,662.

A timely filed terminal disclaimer in compliance with 37 C.F.R. 1.321 may be used to overcome a rejection based on non-statutory double patenting. Although not appearing in the

information on PAIR for the instant application, Applicants note that terminal disclaimers to U.S. Patent No. 6,258,576; U.S. Patent No. 5,612,540; and U.S. Patent No. 6,241,662 were filed in Preliminary Remarks to this application on November 14, 2003. While Applicants do not believe it necessary in light of the previously-filed terminal disclaimers, Applicants have filed executed terminal disclaimers to U.S. Pat. Nos. 6,258,576; 5,612,540; and 6,241,662 concurrently herewith for the convenience of the Patent Office. Applicants have also filed terminal disclaimers to U.S. Patent No. 6,135,965, U.S. Patent No. 6,095,982, and U.S. Patent No. 5,697,373 concurrently herewith.

Applicants wish to point out to the Patent Office that the face of U.S. Patent No. 6,241,662 (the '662 Patent) lists LifeSpex, Inc. as the assignee. However, the purported assignment to LifeSpex, Inc. for that patent was void, and ownership of that patent has and does lie with Board of Regents, The University of Texas System, as evidenced by the material behind Appendix H. Applicants also note that the description of the Assignee in the Assignment from LifeSpex to the Board of Regents of the University of Texas did not include the word "System". However, as shown in the included Agreed Final Judgment and Permanent Injunction, the owner of the '662 Patent is the Board of Regents, The University of Texas System. Therefore, the '662 Patent and the pending U.S. App. No. 10/688,152 are commonly owned.

Applicants also wish to point out that the filing of a terminal disclaimer to obviate a rejection based on non-statutory double patenting is not an admission of the propriety of the rejection. *Quad Environmental Technologies Corp. vs. Union Sanitary District*, 20 U.S.P.Q.2d 1392 (Fed. Cir. 1991).

In light of the present terminal disclaimers, the obviousness-type double patenting rejection of claims 54-85 is believed to be overcome, and favorable reconsideration is therefore requested.

### **Conclusion**

Applicants believe that these remarks fully address all outstanding matters for this application.

It is believed that no fees are required in connection with the filing of this document. However, should any fees under 37 C.F.R. §§ 1.16 to 1.21 be required for any reason relating to the filing of this document, the Commissioner is authorized to deduct said fees from Fulbright & Jaworski Deposit Account No. 50-1212/UTSB:713US/MCB.

Should the Office desire to discuss this case, the Examiner is encouraged to contact the undersigned attorney at (512) 536-3018.

Respectfully submitted,



Chris W. Spence  
Reg. No. 58,806  
Attorney for Applicants

FULBRIGHT & JAWORSKI L.L.P.  
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Date: Dec. 6, 2006

# **APPENDIX A**

## ABSTRACT

Fluorescence spectral data acquired from tissues in vivo or in vitro is processed in accordance with a multivariate statistical method to achieve the ability to probabilistically classify tissue in a diagnostically useful manner, such as by histopathological classification. The apparatus includes a controllable illumination device for emitting electromagnetic radiation selected to cause tissue to produce a fluorescence intensity spectrum. Also included are an optical system for applying the plurality of radiation wavelengths to a tissue sample, and a fluorescence intensity spectrum detecting device for detecting an intensity of fluorescence spectra emitted by the sample as a result of illumination by the controllable illumination device. The system also include a data processor, connected to the detecting device, for analyzing detected fluorescence spectra to calculate a probability that the sample belongs in a particular classification. The data processor analyzes the detected fluorescence spectra using a multivariate statistical method. ~~The five primary steps involved in the multivariate statistical method are (i) preprocessing of spectral data from each patient to account for inter-patient variation, (ii) partitioning of the preprocessed spectral data from all patients into calibration and prediction sets, (iii) dimension reduction of the preprocessed spectra in the calibration set using principal component analysis, (iv) selection of the diagnostically most useful principal components using a two-sided unpaired student's t test and (v) development of an optimal classification scheme based on logistic discrimination using the diagnostically useful principal component scores of the calibration set as inputs.~~

# **APPENDIX B**

28/33

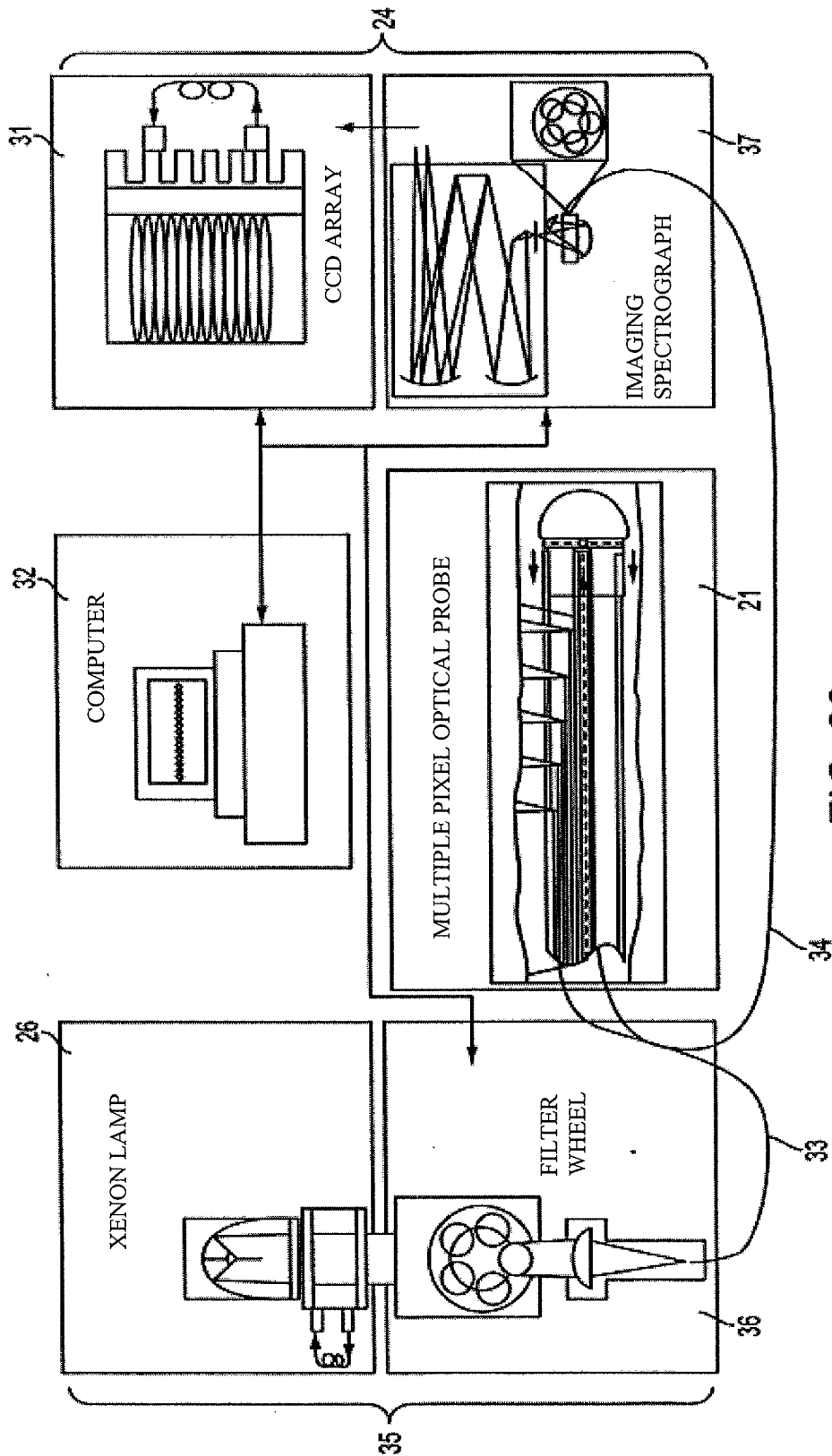


FIG. 26

## **APPENDIX C**



David Blanke  
Michelle Miller

FILED  
FEDERAL BUREAU OF INVESTIGATION  
2004 JA 28 AM 10:12

WESTERN DISTRICT OF TEXAS  
U.S. CLERK'S OFFICE  
BY: SH DEPUTY

CIVIL ACTION NO. A-03-CA-755-SS

**LIFESPEX, INC.,**

*Defendant.*

Before the Court is the agreement between the plaintiff, Board of Regents of the University of Texas System (the "*Board*"), on behalf of The University of Texas at Austin ("*UT*"), and the defendant, LifeSpex, Inc. ("*LifeSpex*"), to the entry of this Agreed Judgment.

WHEREAS, LifeSpex recognizes and acknowledges that (i) it is the holder of bare record title to the '662 Patent and holds such title in constructive trust for the Board; and (ii) the assignment of the '662 Patent to LifeSpex was erroneous.

WHEREAS, LifeSpex represents and warrants that no other agreement affecting the '662 Patent has been or will be made, other than as provided for below;

WHEREAS, UT and LifeSpex stipulate to the dismissal with prejudice of UT's claims for monetary damages. *See* FED. R. CIV. P. 41(a)(1)(ii).

AND WHEREAS, the parties desire to finally resolve any and all matters in dispute between them in relation to this litigation on the terms specified in this Agreed Judgment.

IT IS HEREBY ORDERED, ADJUDGED AND DECREED, that this Court has jurisdiction over the subject matter of this suit and personal jurisdiction of LifeSpex;

IT IS HEREBY ORDERED, ADJUDGED AND DECREED that LifeSpex, and each of its agents, servants and employees, attorneys, and all parties in privity are hereby permanently enjoined from selling, conveying, encumbering, or otherwise alienating any interest in the '662 Patent;

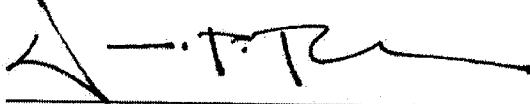
IT IS HEREBY ORDERED, ADJUDGED AND DECREED that the assignment of the '662 Patent, which is Exhibit 1 to this Agreed Judgment is hereby cancelled, and LifeSpex is directed to execute the form of Assignment appended hereto as Exhibit 2 and to take all other and further steps as may be required in order to restore ownership of the '662 Patent to the Board.

IT IS HEREBY ORDERED, ADJUDGED AND DECREED that each party shall bear its attorneys fees and other costs incurred in this lawsuit.

SIGNED and entered this 27<sup>th</sup> day of January 2004.

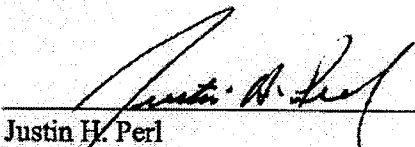
  
UNITED STATES DISTRICT COURT JUDGE

**AGREED TO AND APPROVED:**



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UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
ASSISTANT SECRETARY AND COMMISSIONER  
OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

JULY 13, 1999

PTAS

FISH & RICHARDSON P.C.  
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UNITED STATES PATENT AND TRADEMARK OFFICE  
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PLEASE REVIEW ALL INFORMATION CONTAINED ON THIS NOTICE. THE INFORMATION CONTAINED ON THIS RECORDATION NOTICE REFLECTS THE DATA PRESENT IN THE PATENT AND TRADEMARK ASSIGNMENT SYSTEM. IF YOU SHOULD FIND ANY ERRORS OR HAVE QUESTIONS CONCERNING THIS NOTICE, YOU MAY CONTACT THE EMPLOYEE WHOSE NAME APPEARS ON THIS NOTICE AT 703-308-9723. PLEASE SEND REQUEST FOR CORRECTION TO: U.S. PATENT AND TRADEMARK OFFICE, ASSIGNMENT DIVISION, BOX ASSIGNMENTS, CG-4, 1213 JEFFERSON DAVIS HWY, SUITE 320, WASHINGTON, D.C. 20231.

RECORDATION DATE: 05/04/1999

REEL/FRAME: 9934/0120  
NUMBER OF PAGES: 6

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:

RICHARDS-KORTUM, REBECCA

DOC DATE: 12/31/1998

ASSIGNOR:

AGRAWAL, ANANT

DOC DATE: 01/21/1999

ASSIGNOR:

PITRIS, COSTAS

DOC DATE: 02/01/1999

ASSIGNOR:

UTZINGER, URS

DOC DATE: 01/20/1999

ASSIGNOR:

BROOKNER, CARRIE

DOC DATE: 01/21/1999

ASSIGNOR:

MITCHELL, MICHELE FOLLEN

DOC DATE: 04/29/1999

RECEIVED

JUL 22 1999

FISH & RICHARDSON

EXHIBIT 1

9934/0120 PAGE 2

ASSIGNEE:

LIFESPEX, INC.  
11335 NE 112ND WAY, SUITE 175  
KIRKLAND, WASHINGTON 98034

SERIAL NUMBER: 09175232  
PATENT NUMBER:

FILING DATE: 10/20/1998  
ISSUE DATE:

LAWAN FLETCHER, EXAMINER  
ASSIGNMENT DIVISION  
OFFICE OF PUBLIC RECORDS

05-11-1999

Assistant Commissioner for Patents: PI



101035427

Original document

1. Name of conveying party(ies):  
 Rebecca Richards-Kortum  
 Anant Agrawal  
 Costas Pitris  
 Urs Utzinger  
 Carrie Brookner  
 Michele Follen Mitchell

Address of receiving party(ies):

Linsipex, Inc.

11335 NE 112nd Way, Suite 175  
 Kirkland, Washington 98034

MAY 4 2000

Additional names/addresses attached? ☐ Yes ☒ NoAdditional name(s) attached? ☐ Yes ☒ No

3. Nature of conveyance:  
☒ Assignment  
☐ Merger  
☐ Security Agreement  
☐ Change of Name  
☐ Other:

Execution Date: 12/31/98; 1/21/99; 2/1/99; 1/20/99;  
 1/21/99; 1/29/99, respectively

4. Application number(s) or patent number(s):  
 If this document is being filed with a new application, the execution date of the application is:  
 A. Patent Application No.(s):  
 09/175,232, filed 10/20/98

B. Patent No.(s):

Additional numbers attached? ☐ Yes ☒ No

5. Name/address of party to whom correspondence concerning document should be mailed:

John Land, Reg. No. 29,554  
 Fish & Richardson P.C.  
 4225 Executive Square, Suite 1400  
 La Jolla, CA 92037

6. Total number of applications/patents involved: 1

7. Total fee (37 CFR 3.41): \$40

☒ Enclosed☐ Authorized to charge deposit account

8. Deposit account number: 06-1050

If the fee above is being charged to deposit account, a duplicate copy of this cover sheet is attached. Please apply any additional charges, or any credits, to our Deposit Account No. 06-1050.

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9. Statement and signature: To the best of my knowledge and belief, the foregoing information is true and correct and the attached is a true copy of the original document.

John Land, Reg. No. 29,554

Name of Person Signing

Signature

Date

Total number of pages including cover sheet, attachments, and document: 6

05/11/1999 JNGUYEN 00000075 09175232

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Date of Deposit

I hereby certify under 37 CFR 1.8(a) that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage on the date indicated above and is addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.

NANCY GRANT

Nancy Grant

## ASSIGNMENT

For valuable consideration, we, Rebecca Richards-Kortum, of Austin, Texas; Anant Agrawal, of Austin, Texas; Costas Pitris, of Austin, Texas; Urs Utzinger, of Austin, Texas; Carrie Brookner, of Missouri City, Texas; Michele Follen Mitchell, of Houston, Texas hereby assign to LifeSpex, Inc., a corporation having a place of business at 11335 NE 122nd Way, Suite 175, Kirkland, Washington 98034, and its successors and assigns (collectively hereinafter called "the Assignee"), the entire right, title and interest throughout the world in the inventions and improvements which are subject of an application for United States Patent signed by us this day, entitled ACETIC ACID AS A SIGNAL ENHANCING CONTRAST AGENT IN FLUORESCENCE SPECTROSCOPY, filed October 20, 1998 and assigned U.S. Serial Number 09/175,232, and we authorize and request the attorneys appointed in said application to hereafter complete this assignment by inserting above the filing date and serial number of said application when known; this assignment including said application, any and all United States and foreign patents, utility models, and design registrations granted for any of said inventions or improvements, and the right to claim priority based on the filing date of said application under the International Convention for the Protection of Industrial Property, the Patent Cooperation Treaty, the European Patent Convention, and all other treaties of like purposes; and we authorize the Assignee to apply in all countries in our name or in its own name for patents, utility models, and design registrations and like rights of exclusion and for inventors' certificates for said inventions and improvements; and we agree for ourselves and our respective heirs, legal representatives and assigns, without further compensation to perform such lawful acts and to sign such further applications, assignments, Preliminary Statements and other lawful documents as the Assignee may reasonably request to effectuate fully this assignment.

Date: 12/31/98

Rebecca Richards-Kortum  
Rebecca Richards-Kortum

Date: \_\_\_\_\_

\_\_\_\_\_  
Anant Agrawal

Date: 1/

\_\_\_\_\_  
Costas Pitris

Date: 1/26/1999

Urs Utzinger  
Urs Utzinger

Date: \_\_\_\_\_

\_\_\_\_\_  
Carrie Brookner

Date: \_\_\_\_\_

\_\_\_\_\_  
Michele Follen Mitchell

# ASSIGNMENT

For valuable consideration, we, Rebecca Richards-Kortum, of Austin, Texas; Anant Agrawal, of Austin, Texas; Costas Pitris, of Austin, Texas; Urs Utzinger, of Austin, Texas; Carrie Brookner, of Missouri City, Texas; Michele Follen Mitchell, of Houston, Texas hereby assign to LifeSpec, Inc., a corporation having a place of business at 11335 NE 122nd Way, Suite 175, Kirkland, Washington 98034, and its successors and assigns (collectively hereinafter called "the Assignee"), the entire right, title and interest throughout the world in the inventions and improvements which are subject of an application for United States Patent signed by us this day, entitled ACETIC ACID AS A SIGNAL ENHANCING CONTRAST AGENT IN FLUORESCENCE SPECTROSCOPY, filed October 20, 1998 and assigned U.S. Serial Number 09/175,232, and we authorize and request the attorneys appointed in said application to hereafter complete this assignment by inserting above the filing date and serial number of said application when known; this assignment including said application, any and all United States and foreign patents, utility models, and design registrations granted for any of said inventions or improvements, and the right to claim priority based on the filing date of said application under the International Convention for the Protection of Industrial Property, the Patent Cooperation Treaty, the European Patent Convention, and all other treaties of like purposes; and we authorize the Assignee to apply in all countries in our name or in its own name for patents, utility models, and design registrations and like rights of exclusion and for inventors' certificates for said inventions and improvements; and we agree for ourselves and our respective heirs, legal representatives and assigns, without further compensation to perform such lawful acts and to sign such further applications, assignments, Preliminary Statements and other lawful documents as the Assignee may reasonably request to effectuate fully this assignment.

Date: 12/31/98

Rebecca Richards-Kortum  
Rebecca Richards-Kortum

Date: 1/21/99

Anant Agrawal  
Anant Agrawal

Date: 1/

Costas Pitris

Date: 1/20/1999

Urs Utzinger  
Urs Utzinger

Date: \_\_\_\_\_

Carrie Brookner  
Carrie Brookner

Date: \_\_\_\_\_

Michele Follen Mitchell  
Michele Follen Mitchell



## ASSIGNMENT

For valuable consideration, we, Rebecca Richards-Kortum, of Austin, Texas; Anant Agrawal, of Austin, Texas; Costas Pitsis, of Austin, Texas; Urs Utzinger, of Austin, Texas; Carrie Brookner, of Missouri City, Texas; Michele Pollen Mitchell, of Houston, Texas hereby assign to LifeSpex, Inc., a corporation having a place of business at 11335 NE 122nd Way, Suite 175, Kirkland, Washington 98034, and its successors and assigns (collectively hereinafter called "the Assignee"), the entire right, title and interest throughout the world in the inventions and improvements which are subject of an application for United States Patent signed by us this day, entitled ACETIC ACID AS A SIGNAL ENHANCING CONTRAST AGENT IN FLUORESCENCE SPECTROSCOPY, filed October 20, 1998 and assigned U.S. Serial Number 09/175,232, and we authorize and request the attorneys appointed in said application to hereafter complete this assignment by inserting above the filing date and serial number of said application when known; this assignment including said application, any and all United States and foreign patents, utility models, and design registrations granted for any of said inventions or improvements, and the right to claim priority based on the filing date of said application under the International Convention for the Protection of Industrial Property, the Patent Cooperation Treaty, the European Patent Convention, and all other treaties of like purposes; and we authorize the Assignee to apply in all countries in our name or in its own name for patents, utility models, and design registrations and like rights of exclusion and for inventors' certificates for said inventions and improvements; and we agree for ourselves and our respective heirs, legal representatives and assigns, without further compensation to perform such lawful acts and to sign such further applications, assignments, Preliminary Statements and other lawful documents as the Assignee may reasonably request to effectuate fully this assignment.

Date: 12/31/98Rebecca Richards-Kortum  
Rebecca Richards-Kortum

Date: \_\_\_\_\_

Anant Agrawal

Date: 2/1/99Costas Pitsis  
Costas PitsisDate: 1/20/1999Urs Utzinger  
Urs Utzinger

Date: \_\_\_\_\_

Carrie Brookner

Date: \_\_\_\_\_

Michele Pollen Mitchell  
Michele Pollen Mitchell

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Date: 12/31/98Rebecca Richards-Kortum  
Rebecca Richards-Kortum

Date: \_\_\_\_\_

Anant AgrawalDate: 1/Costas PitrisDate: 1/20/1999Urs Utzinger

Date: \_\_\_\_\_

Carrie BrooknerDate: 1/29/99Michele Follen Mitchell

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Date: 12/31/98Rebecca Richards-Kortum  
Rebecca Richards-Kortum

Date: \_\_\_\_\_

Anant Agrawal

Date: \_\_\_\_\_

Costas Pitris

Date: \_\_\_\_\_

Urs UtzingerDate: 1/21/99Carrie Brookner  
Carrie Brookner

Date: \_\_\_\_\_

Michele Follen Mitchell

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Date: 12/31/98

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Date: 1/29/99

7766L11

Rebecca Richards-Kortum  
Rebecca Richards-Kortum

Anant Agrawal

Costas Pitris

Urs Utzinger

Carrie Brookner

Michele Follen Mitchell

## ASSIGNMENT

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Date: 12/31/98Rebecca Richards-Kortum  
Rebecca Richards-Kortum

Date: \_\_\_\_\_

Anant AgrawalDate: 2/1/99Costas Piris  
Costas PirisDate: 1/20/1999Urs Utzinger  
Urs Utzinger

Date: \_\_\_\_\_

Carrie Brookner  
Carrie Brookner

Date: \_\_\_\_\_

Michele Follen Mitchell  
Michele Follen Mitchell

## ASSIGNMENT

For valuable consideration, we, Rebecca Richards-Kortum, of Austin, Texas; Anant Agrawal, of Austin, Texas; Costas Pitris, of Austin, Texas; Urs Utzinger, of Austin, Texas; Carrie Brookner, of Missouri City, Texas; Michele Follen Mitchell, of Houston, Texas hereby assign to LifeSpec, Inc., a corporation having a place of business at 11335 NE 122nd Way, Suite 175, Kirkland, Washington 98034, and its successors and assigns (collectively hereinafter called "the Assignee"), the entire right, title and interest throughout the world in the inventions and improvements which are subject of an application for United States Patent signed by us this day, entitled ACETIC ACID AS A SIGNAL ENHANCING CONTRAST AGENT IN FLUORESCENCE SPECTROSCOPY, filed October 20, 1998 and assigned U.S. Serial Number 09/175,232, and we authorize and request the attorneys appointed in said application to hereafter complete this assignment by inserting above the filing date and serial number of said application when known; this assignment including said application, any and all United States and foreign patents, utility models, and design registrations granted for any of said inventions or improvements, and the right to claim priority based on the filing date of said application under the International Convention for the Protection of Industrial Property, the Patent Cooperation Treaty, the European Patent Convention, and all other treaties of like purposes; and we authorize the Assignee to apply in all countries in our name or in its own name for patents, utility models, and design registrations and like rights of exclusion and for inventors' certificates for said inventions and improvements; and we agree for ourselves and our respective heirs, legal representatives and assigns, without further compensation to perform such lawful acts and to sign such further applications, assignments, Preliminary Statements and other lawful documents as the Assignee may reasonably request to effectuate fully this assignment.

Date: 12/31/98Rebecca Richards-Kortum  
Rebecca Richards-Kortum

Date: \_\_\_\_\_

Anant Agrawal

Date: \_\_\_\_\_

Costas Pitris

Date: \_\_\_\_\_

Urs UtzingerDate: 1/21/99Carrie Brookner  
Carrie Brookner

Date: \_\_\_\_\_

Michele Follen Mitchell

ASSIGNMENT

FOR GOOD AND VALUABLE CONSIDERATION, the receipt, sufficiency and adequacy of which are hereby acknowledged, the undersigned, does hereby:

SELL, ASSIGN AND TRANSFER to the Board of Regents of the University of Texas at Austin. (the "Assignee"), having a place of business at Office of Technology Licensing and Intellectual Property, 3925 West Braker Lane, Suite 1.9A, Mail Code R3500, Austin Texas, 78759, the entire right, title and interest, whether vested or contingent, presently held by the undersigned for the United States and all foreign countries, in and to any and all improvements which are disclosed in United States Letters Patent Application Serial No. 09/175,232 filed on October 20, 1998, and issued June 5, 2001 as U.S. Patent No. 6,241,662, recorded at the U.S. Patent and Trademark Office, Reel 9934, Frame 0120 and is entitled "Acetic Acid as a Signal Enhancing Contrast Agent in Fluorescence Spectroscopy." This sale, assignment and transfer applies to such application and all divisional, continuing, continuation-in-part, substitute, renewal, reissue and all other applications for patent which have been or shall be filed in the United States and all foreign countries on any of such improvements; all original and reissued patents which have been or shall be issued in the United States and all foreign countries on such improvements; and specifically including the right to file foreign applications under the provisions of any convention or treaty and claim priority based on such application in the United States;

AUTHORIZE AND REQUEST the issuing authority to issue any and all United States and foreign patents granted on such improvements to the Assignee;

WARRANT AND COVENANT that the Board of Regents of the University of Texas at Austin is the proper owner, and holds or should hold all rights under and title to, the Patent Application, U.S. Patent No. 6,241,662 and any other patents that may result or relate to the Patent Application and that the prior assignment to LifeSpex, Inc. was made in error and without valid consideration and is therefore void or voidable under Texas law, cancelled and rescinded; and further warrants and covenants that no other assignment, grant, mortgage, license or other agreement affecting the rights and property herein conveyed has been or will be made to others by the undersigned;

COVENANT that, when requested and at the expense of the Assignee, to carry out in good faith the intent and purpose of this assignment, the undersigned will execute all divisional, continuing, substitute, renewal, reissue, and all other patent applications on any and all such improvements; execute all rightful oaths, declarations, assignments, powers of attorney and other papers; communicate to the Assignee all facts known to the undersigned relating to such improvements and the history thereof, and generally do everything possible which the Assignee shall consider desirable for securing, maintaining and enforcing proper patent protection for such improvements and for vesting title to such improvements in the Assignee;

TO BE BINDING on the heirs, assigns, representatives and successors of the undersigned and extend to the successors, assigns and nominees of the Assignee.

(Signature) \_\_\_\_\_ Date: \_\_\_\_\_  
Name: LifeSpex, Inc.

BEFORE ME, the undersigned authority, on this \_\_\_\_ day of \_\_\_\_\_, 2003,  
personally appeared \_\_\_\_\_, known to me to be the person whose name is  
subscribed to the foregoing instrument and acknowledge to me that (s)he executed the same of (her) his  
own free will for the purposes and consideration therein expressed.

\_\_\_\_\_  
Notary or Consular Officer

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YOU COULD HAVE RECEIVED THIS NOTICE YESTERDAY BY FAX.

Just complete and return the authorization below and you will receive notice of orders and judgments which do not require special mailing requirements, within hours of their entry on WESTERN DISTRICT OF TEXAS cases in which you would normally be noticed. It's FREE and it's FAST. DO NOT SUBMIT MORE THAN ONE AUTHORIZATION. Allow 2 weeks to process.

M. Michelle Muller  
Vinson & Elkins, L.L.P.  
2801 Via Fortuna  
Suite 100  
Austin, TX 78746

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1:03-cv-00755 #7  
16 page(s)  
01/28/04  
tdk  
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AUTHORIZATION TO SEND ORDERS AND  
JUDGMENTS BY FACSIMILE TRANSMISSION

The Clerk of Court for the Western District of Texas is authorized to transmit notice of entries of judgments and orders under Fed.R.Civ.P. 77, Fed.R.Crim.P. 49 by facsimile transmission in ANY WESTERN DISTRICT OF TEXAS CASE in which this capability exists, and the undersigned appears as attorney of record. I understand that this electronic notice will be in lieu of notice by mail. The following telephone number is dedicated for facsimile transmissions.

FAX NUMBER : \_\_\_\_\_ Firm Name \_\_\_\_\_  
Signature: \_\_\_\_\_ Address: \_\_\_\_\_  
Printed Name: \_\_\_\_\_  
State Bar No: \_\_\_\_\_ Phone No: \_\_\_\_\_

Mail to: Clerk, Western District of Texas  
Attn: Operations/Quality Control  
727 E. Durango Blvd. - Suite A500  
San Antonio, TX 78206

Or Fax to: 210-472-6587, Attn: Operations/Quality Control

Visit our website at: [www.txwd.uscourts.gov](http://www.txwd.uscourts.gov)

OMB No. 0651-0011 (exp. 4/94)

## PATENTS ONLY

Patent and Trademark Office

To the Honorable Commissioner of Patents and Trademarks: Please record the attached original document or copy thereof.

## 1. Name of conveying party(ies):

Rebecca Richards-Kortum, Michele Follen, Urs  
Utzinger, Carrie Brookner, Anant Agrawal, and Costas  
PitrisAdditional name(s) of conveying party(ies) attached? ☐ Yes ☒ No

## 3. Nature of conveyance:

☒ Assignment☐ Merger☐ Security Agreement☐ Change of Name☒ Other Declaration regarding ownership of patentExecution Date: Assignment - 06/05/03, 05/22/03, 05/22/03,  
05/29/03, 05/23/03, 10/06/03; Declaration - 10/14/03

## 2. Name and address of receiving party(ies):

Name: Board of Regents, The University of  
Texas SystemStreet Address: 201 West 7<sup>th</sup> Street

City: Austin State: Texas Zip: 78701

Additional name(s) & address(es) attached? ☐ Yes ☒ No

## 4. Application number(s) or registration number(s):

If this document is being filed together with a new application, the execution date of the application is:

A. Patent Application No.(s):

B. Patent No.(s):

6,241,662

Additional numbers attached? ☐ Yes ☒ No5. Name and address of party to whom correspondence concerning  
document should be mailed:Name: Michael C. Barrett  
FULBRIGHT & JAWORSKI, L.L.P.  
600 Congress Avenue, Suite 2400

City: Austin State: Texas Zip: 78701

6. Total number of applications and patents involved: 17. Total fee (37 C.F.R. 3.41)----- \$ 40.00☒ Enclosed☒ Authorized to be charged to deposit account

if check insufficient or inadvertently omitted

8. Deposit account number: 50-1212/TUUT:014US

(Attach duplicate copy of this page if paying by deposit account)

DO NOT USE THIS SPACE

## 9. Statement and signature.

*To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document.*

Michael C. Barrett

Michael C. Barrett

11/04/2003

Name of Person Signing, Reg. No. 44,523

Signature

Date

Total number of pages including cover sheet, attachments and documents: 9Mail documents to be recorded with required cover sheet information to:  
Director of the U.S. Patent and Trademark, Box Assignment, Alexandria, VA 22313-1450CERTIFICATE OF MAILING  
37 C.F.R. 1.8I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as First Class Mail in an envelope  
addressed to: Director of the U.S. Patent and Trademark, Box Assignment, Alexandria, VA 22313-1450, on the date below:November 4, 2003  
Date

Michael C. Barrett

**Assignment of Rights, Title and Interest in Invention**  
**(Multiple inventors; single assignee)**  
**Docket No. TUUT:014**

FOR GOOD AND VALUABLE CONSIDERATION, the receipt, sufficiency and adequacy of which are hereby acknowledged, WE the undersigned, do hereby:

SELL, ASSIGN AND TRANSFER to Board of Regents, The University of Texas System, (the "Assignee"), having an address of 201 W. 7th St., Austin, Texas 78701, the entire right, title and interest in and to any and all inventions which are disclosed in United States Patent Number 6,241,662 (Application Serial No. 09/175,232, filed on October 20, 1998), which issued on June 5, 2001, and is entitled "Acetic Acid as a Signal Enhancing Contrast Agent in Fluorescence Spectroscopy", such application and all divisional, continuing, substitute, renewal, reissue and all other applications for patent which have been or shall be filed in all foreign countries on any of such inventions; and all original and reissued patents which have been or shall be issued in all foreign countries on such inventions.

AUTHORIZE AND REQUEST the issuing authority to issue any and all foreign patents granted on such inventions to the Assignee;

WARRANT AND COVENANT its belief that no assignment, grant, mortgage, license or other agreement affecting the rights and property herein conveyed has been or will be made to others by the undersigned, and that the full right to convey the same as herein expressed is possessed by the undersigned:

COVENANT, when requested and at the expense of the Assignee, to carry out in good faith the intent and purpose of this assignment, the undersigned will execute all divisional, continuing, substitute, renewal, reissue, and all other patent applications on any and all such inventions; execute all rightful oaths, declarations, assignments, powers of attorney and other papers; communicate to the Assignee all facts known to the undersigned relating to such inventions and the history thereof; and generally do everything possible to vest title to such inventions in the Assignee, and for securing, maintaining and enforcing proper patent protection for such inventions;

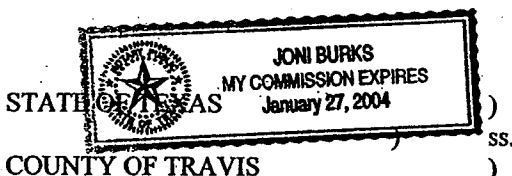
TO BE BINDING on the heirs, assigns, representatives and successors of the undersigned and extend to the successors, assigns and nominees of the Assignee.

(Signature)

Rebecca Richards-Kortum Date 6/5/03

Name:

Rebecca Richards-Kortum



BEFORE ME, the undersigned authority, on this 5 day of June, 2003, personally appeared Rebecca Richards-Kortum known to me to be the person whose name is subscribed to the foregoing instrument and acknowledged to me that he/she executed the same of his/her own free will for the purposes and consideration therein expressed.

{SEAL}

\_\_\_\_\_  
Notary or Consular Officer

{SEAL}

\_\_\_\_\_  
Notary or Consular Officer

**Assignment of Rights, Title and Interest in Invention  
(Multiple inventors; single assignee)  
Docket No. TUUT:014**

(Signature)

Michele Follen Date 5/22/03

Name:

Michele Follen

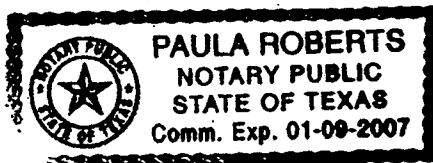
STATE OF TEXAS

COUNTY OF Harris

)  
ss.  
)

BEFORE ME, the undersigned authority, on this 22<sup>nd</sup> day of May, 2003, personally appeared Michele Follen, known to me to be the person whose name is subscribed to the foregoing instrument and acknowledged to me that he/she executed the same of his/her own free will for the purposes and consideration therein expressed.

{SEAL}



Paula Roberts  
Notary or Consular Officer

Assignment of Rights, Title and Interest in Invention  
(Multiple inventors; single assignee)  
Docket No. TUUT:014

(Signature)

[Signature]

Date 5/22/03

Name:

Urs Utzinger

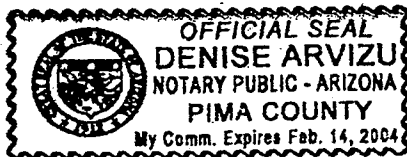
STATE OF ARIZONA )

COUNTY OF Arizona )

ss.

BEFORE ME, the undersigned authority, on this 22nd day of May, 2003, personally appeared Arizona Cancer Center, known to me to be the person whose name is subscribed to the foregoing instrument and acknowledged to me that he/she executed the same of his/her own free will for the purposes and consideration therein expressed.

{SEAL}



[Signature]  
Notary or Consular Officer

(Signature)

Date \_\_\_\_\_

Name:

Carrie Brookner

STATE OF NEW JERSEY )

COUNTY OF \_\_\_\_\_ )

ss.

BEFORE ME, the undersigned authority, on this \_\_\_\_\_ day of \_\_\_\_\_, \_\_\_\_\_, personally appeared \_\_\_\_\_, known to me to be the person whose name is subscribed to the foregoing instrument and acknowledged to me that he/she executed the same of his/her own free will for the purposes and consideration therein expressed.

Assignment of Rights, Title and Interest in Invention  
(Multiple inventors; single assignee)  
Docket No. TUUT:014

(Signature)

\_\_\_\_\_ Date \_\_\_\_\_

Name:

Urs Utzinger

STATE OF ARIZONA

)

)

ss.

COUNTY OF \_\_\_\_\_

)

BEFORE ME, the undersigned authority, on this \_\_\_\_\_ day of \_\_\_\_\_, \_\_\_\_\_, personally appeared \_\_\_\_\_, known to me to be the person whose name is subscribed to the foregoing instrument and acknowledged to me that he/she executed the same of his/her own free will for the purposes and consideration therein expressed.

{SEAL}

\_\_\_\_\_  
Notary or Consular Officer

(Signature)

Carrie Brookner Date 5/29/03

Name:

Carrie Brookner

STATE OF NEW JERSEY

)

)

ss.

COUNTY OF Somerset

)

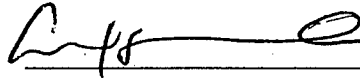
BEFORE ME, the undersigned authority, on this 29th day of May, 2003, personally appeared Carrie Brookner, known to me to be the person whose name is subscribed to the foregoing instrument and acknowledged to me that he/she executed the same of his/her own free will for the purposes and consideration therein expressed.

{SEAL}

Jane A. Recchia  
Notary or Consular Officer

Assignment of Rights, Title and Interest in Invention  
(Multiple inventors; single assignee)  
Docket No. TUUT:014

(Signature)



Date 5/23/2003

Name:

Anant Agrawal

STATE OF GEORGIA

COUNTY OF FULTON

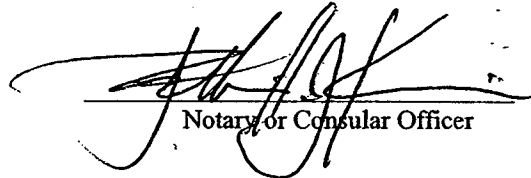
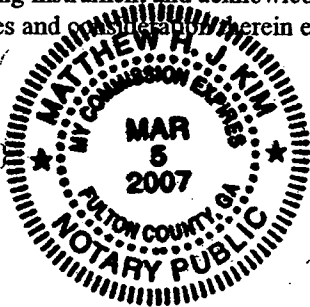
)

ss.

)

BEFORE ME, the undersigned authority, on this 23<sup>RD</sup> day of MAY, 2003, personally appeared ANANT AGRAWAL, known to me to be the person whose name is subscribed to the foregoing instrument and acknowledged to me that he/she executed the same of his/her own free will for the purposes and consideration therein expressed.

{SEAL

  
Notary or Consular Officer

(Signature)

Date

Name:

Costas Pitris

CYPRUS

COUNTY OF \_\_\_\_\_

)

ss.


)

BEFORE ME, the undersigned authority, on this \_\_\_\_\_ day of \_\_\_\_\_, \_\_\_\_\_, personally appeared \_\_\_\_\_, known to me to be the person whose name is subscribed to the foregoing instrument and acknowledged to me that he/she executed the same of his/her own free will for the purposes and consideration therein expressed.

Assignment of Rights, Title and Interest in Invention  
(Multiple inventors; single assignee)  
Docket No. TUUT:014

(Signature)

Name:

 Date 10/6/2003  
Costas Pitris

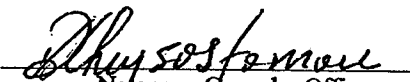
CYPRUS

COUNTY OF \_\_\_\_\_

)  
ss.  
)

BEFORE ME, the undersigned authority, on this 10<sup>th</sup> day of June, 2003, personally appeared Costas Pitris, known to me to be the person whose name is subscribed to the foregoing instrument and acknowledged to me that he/she executed the same of his/her own free will for the purposes and consideration therein expressed.

{SEAL}

  
Notary or Consular Officer  
President of the Community  
of Aglantzia-Nicosia-Cyprus



10/6/2003  
Tel. 22339638



**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

*In re* Patent of:  
Richards-Kortum, *et al.*

Atty. Dkt. No.: UNI918/75009

U.S. Pat. No.: 6,241,662

Filed: October 20, 1998

For: ACETIC ACID AS A SIGNAL  
ENHANCING CONTRAST AGENT IN  
FRUORESCENCE SPECTROSCOPY

**DECLARATION OF CULLEN M. GODFREY**

I, CULLEN M. GODFREY, HEREBY DECLARE AS FOLLOWS:

1. I am Vice Chancellor and General Counsel in the Office of the General Counsel of The University of Texas System ("UT System").

2. The inventors of the above-referenced U.S. Patent ("the '662 patent") were all employees of the University of Texas at Austin, a component institution of UT System at the time that the claimed invention was made. As a term of their employment, all of the inventors were contractually bound by the intellectual property policy of the UT System (see [http://www.utsystem.edu/bor/rules/MasterRRR.htm#\\_Toc49851668](http://www.utsystem.edu/bor/rules/MasterRRR.htm#_Toc49851668)).

3. It is the policy of the Board of Regents of The University of Texas System ("the Board") that intellectual property either related to the individual's employment responsibility, or resulting from activities performed on UT System time, or from using UT System facilities is subject to ownership by the Board. This was the policy of the UT System at the time that the inventors developed the subject matter in the '662 patent. Therefore, because the patented invention was developed as a result of activities relating to the inventors' employment responsibilities, performed on UT System time and through the use of UT System facilities, the invention of the '662 patent was subject to ownership by the Board. By the terms of the

intellectual property policy, the Board effectively asserted its ownership interest in the '662 patent no later than October 20, 1998, the date when the patent application was filed.

4. It is a further policy of the Board, again, to which the inventors were contractually bound by the terms of their employment agreement, that all employees assign the rights to intellectual property and patents to the Board when such creations are subject to ownership by the Board and the Board elects to assert its ownership interest. As stated in ¶3 above, the inventions of the '662 patent were subject to Board ownership, and the Board asserted ownership of these inventions. Dr. Neil Iscoe, Director, Office of Technology Licensing, The University of Texas at Austin, recently confirmed to me that the inventors of the '662 patent, instead of assigning ownership rights to the Board, mistakenly executed an assignment of their right, title and interest in the '662 patent to LifeSpex, Inc., a licensee of The University of Texas at Austin. Thus, when the inventors executed this incorrect assignment, they held no rights in the '662 patent that could be transferred to a third party, and they were not acting as the agent of Board, the rightful owner of the interest. Thus, under Texas law, the assignment to LifeSpex, Inc. should be held to be void.

5. LifeSpex, Inc. was not a subsequent purchaser or mortgagee for any valuable consideration. Thus, the mistaken assignment to LifeSpex, Inc., which is recorded with the United States Patent and Trademark Office, is not subject to 35 USC §261.

6. The conveyance of all interests in the '662 patent to the Board is reiterated in the assignment by the inventors that is submitted concurrently with this declaration.

7. All statements made in this Declaration of my own knowledge are true and all statements made in this Declaration on information and belief are believed to be true, and these statements are made with the knowledge that willful false statements and the like are punishable by fine or imprisonment, or both under 18 U.S.C. § 1001 and may jeopardize the validity of this patent.

Date: October 14, 2003

  
Cullen M. Godfrey

*Blm*